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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,127	07/26/2002	Gabriele Grassi	WWELL63.001 APC	2519
20995	7590	10/29/2004	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614				ASHEN, JON BENJAMIN
ART UNIT		PAPER NUMBER		
1635				

DATE MAILED: 10/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/089,127	GRASSI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jon B. Ashen	1635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is **FINAL**.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-3,12-14,23,24 and 26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) \_\_\_\_\_ is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) 1-3,12-14, 23-24 and 26 are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-3, 12-14, 23-24 and 26, drawn to a composition for preventing or ameliorating restenosis comprising a catalytically acting RNA or DNA molecule which is directed against mRNA molecules coding for the cell cycle relevant protein cyclin E.

Group II, claim(s) 1-3, 12-14, 23-24 and 26, drawn to a composition for preventing or ameliorating restenosis comprising a catalytically acting RNA or DNA molecule which is directed against mRNA molecules coding for the cell cycle relevant protein E2F1.

2. The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The special technical feature of groups I and II is considered to be a composition for preventing or ameliorating restenosis comprising a catalytically acting RNA molecule which is directed against mRNA molecules coding for the cell cycle relevant proteins cyclin E or E2F1.

However:

3. Claims 3, 12, 13 and 14 specifically claim nucleotide sequences or sequence pairs which are directed against mRNA molecules coding for the cell cycle relevant proteins cyclin E or E2F1. Therefore, this application does not comply with the requirements for unity of invention (Rules 13.1, 13.2 and 13.3) for the following reasons:

4. According to the guidelines in section (f)(i)(a) of annex B of the PCT Administrative Instructions, the special technical feature as defined by PCT Rule 13.2 shall be considered to be met when all the alternatives of a Markush-group are of

similar nature. For chemical alternatives, such as the claimed ribozyme sequences, the Markush group shall be regarded as being of similar nature when

- (A) all alternatives have a common property or activity AND
- (B)(1) a common structure is present, i.e., a significant structure is shared by all the alternatives OR
- (B)(2) in cases where the common structure cannot be the unifying criteria, all alternatives belong to an art recognized class of compounds in the art to which the invention pertains.

5. The instant ribozyme sequences (claimed as the antisense sequence pairs listed in claim 3) are considered to be each separate inventions for the following reasons:

6. The sequences do not meet the criteria of (A), common property or activity or (B)(2), art recognized class of compounds. In the instant case, the sequences target and modulate the expression of either the same or different genes (cyclin E or E2F1) and will each behave differently in the context of the invention, which is a composition for in vivo treatment. Each sequence targets a different and specific region of either the same or a different gene and, absent evidence to the contrary, modifies (increases or decreases) the expression of each gene to varying degrees. Each member of the class cannot be substituted one for the other with the expectation that the same intended result would be achieved.

7. Further, the sequences listed in claims 3, 12, 13 and 14 do not meet the criteria of (B)(1) as they do not share, one with another, a common core structure. Accordingly, unity of invention between ribozyme (antisense) sequences is lacking and each ribozyme (antisense) sequence claimed is considered to constitute a special technical feature.

8. Claims 3, 12, 13 and 14 are subject to an additional restriction since each is not considered to be a proper genus/Markush for the reasons set forth in sections 3-7 above and for the following reasons. See MPEP 803.02 - PRACTICE RE MARKUSH-TYPE CLAIMS - If the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner must examine all the members of the Markush group in the claim on the merits, even though they are directed to independent and

distinct inventions. In such a case, the examiner will not follow the procedure described below and will not require restriction. Since the decisions in *In re Weber*, 580 F.2d 455, 198 USPQ 328 (CCPA 1978) and *In re Haas*, 580 F.2d 461, 198 USPQ 334 (CCPA 1978), it is improper for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention. *In re Harnish*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980); and *Ex parte Hozumi*, 3 USPQ2d 1059 (Bd. Pat. App. & Int. 1984). Broadly, unity of invention exists where compounds included within a Markush group (1) share a common utility, and (2) share a substantial structural feature disclosed as being essential to that utility.

Furthermore, a search of more than one (1) of the antisense sequences claimed in claims 3, 12, 13 and 14 presents an undue burden on the Patent and Trademark Office due to the complex nature of the search and corresponding examination of more than one (1) of the claimed antisense sequences. MPEP 808.02 states in part: Where the related inventions as claimed are shown to be distinct under the criteria of MPEP 806.05(C) - 806.05(i), the examiner, in order to establish reasons for insisting upon restriction, must show by appropriate explanation one of the following:

(C) A different field of search: Where it is necessary to search for one of the distinct subjects in places where no pertinent art to the other subject exists, a different field of search is shown, even though the two are classified together.

It is noted that a search of the available sequence databases produces a listing of references disclosing the sequence most similar to the query sequence. This is the "place" where the examiner searches for prior art. The prior art relating to another query

sequence will not be found in this "place"- a different listing of references must be generated and searched by the examiner. Thus a different search is shown, and restriction is proper.

In view of the foregoing, one (1) antisense sequence is considered to be a reasonable number of sequences for examination. Accordingly, applicant is required to elect a single sequence pair (1) from claim 3, 12 or 13 or a single sequence set forth in claim 14 that corresponds with a target region as claimed in claim 1 that targets the mRNA of cyclin E or E2F1. Note that this is not a species election.

9. Claims 1-3, 12-14 and 23-26 are generic to groups I and II and will be examined in accordance with the subject matter of the group (and corresponding sequence) elected.

10. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jon B. Ashen whose telephone number is 571-272-2913. The examiner can normally be reached on 7:30 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John LeGuyader can be reached on 571-272-0670. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public. For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

Jba

  
SEAN McGARRY  
PRIMARY EXAMINER  
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